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09/788,147	02/16/2001	Kevin H. Gillespie	06129-158001	4293
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FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			EXAMINER PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 23

Application Number: 09/788,147  
Filing Date: February 16, 2001  
Appellant(s): GILLESPIE, KEVIN H.

\_\_\_\_\_  
Michael R. Hamlin  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
**FEB 20 2004**  
**GROUP 3700**

This is in response to the appeal brief filed 1/20/04.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-15, 17-23, and 26-29 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

4897936	FUERST	2-1990
5287638	PRESTON	2-1994
4724624	DUCLOS	2-1988
5768806	PARISOTTO	6-1998
5325611	DYER ET AL	7-1994
6009637	PAVONE	1-2000
9800597	BRASIL PATENT TO SCHENKEL	11-1999
6418641	SCHENKEL (EQUIVALENT TO ABOVE BRASIL PATENT)	7-2002

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-6, 8, 11, 13-15, 17, 22, 23, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Schenkel (Brazil publication PI 9800597-9).

Schenkel shows a shoe comprising an outsole (formed by C, T, S, and R) with apertures (VT and VD), and cushions (E) which are located, flow ("to deform under stress without cracking or rupturing" as defined by Websters Dictionary) and bulge

through the apertures (as shown in figures 5, 6, and 8-10) but do not contact the ground surface (as shown in figures 6, 8, 9, and 10) as claimed.

2. Claims 1, 4-6, 11, 12, 156, 17, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuerst (4897936).

Fuerst shows a shoe with an outsole with apertures (28 and 30) and inserts (50 and 52) therein which bulge and protrude through the apertures as claimed. In reference to the functional recitation of "said lower cushion surface...being spaced...at all times..." is considered an intended use recitation and encompassed by the use of walking which is discussed by Fuerst in column 1 line 65-column 2 line 2).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 11, 15, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preston (5287638) in view of Fuerst.

Preston shows a shoe with an aperture (21) and cushion (24) in the heel of an outsole and a recess in the lower surface of the outsole (figure 3) substantially as claimed except for the exact depth of the recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a recess wall and an insert (52) located within the recessed region and the recess being of such a depth that the insert is spaced above the ground surface at all times in which the wearer

is walking (column 1 line 65- column 2 line 2). It would have been obvious to make the recess of sufficient depth as taught by Fuerst in the shoe of Preston to prevent excessive wear on the inert and thereby extend the useful life of the shoe.

In reference to claims 2 and 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use rubber and thermoplastic resins, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

5. Claims 1 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duclos (4724624) in view of Fuerst.

Duclos shows a shoe comprising an outsole with a grid pattern and loop (figure 2) substantially as claimed except for an aperture in the heel with a cushion. Fuerst teaches providing an insert (52) in an aperture in the heel of an outsole and a recess in a lower surface of the outsole (figure 3). It would have been obvious to provide an aperture, recess, and cushion as taught by Fuerst in the shoe of Duclos to increase cushioning and shock absorption.

6. Claims 1 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parisotto (5768806) in view of Fuerst.

Parisotto shows a shoe comprising an outsole with a grid pattern on the top surface of the outsole (figure 1) substantially as claimed except for an aperture in the heel with a cushion. Fuerst teaches providing an insert (52) in an aperture in the heel of an outsole and a recess in a lower surface of the outsole (figure 3). It would have been obvious to

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provide an aperture, a recess, and cushion as taught by Fuerst in the shoe of Parisotto to increase cushioning and shock absorption.

7. Claims 1, 5, 6, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dyer (5325611) in view of Fuerst.

Dyer shows a shoe substantially as claimed except for a recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a depth so that the insert (52) does not engage the walking surface during weight bearing and heel strike force during normal walking conditions at all times (see column 1 line 65- column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Dyer to increase cushioning and to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

8. Claims 1, 3, 4, 12, 15, 17-23, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pavone (6009637) in view of Fuerst.

Pavone shows a shoe substantially as claimed except for a recess in the lower surface of the outsole. Fuerst teaches providing a recess in the lower surface of an outsole with a depth so that the insert (52) does not engage the walking surface during normal play at all times under normal play (see column 1 line 65- column 2 line 2). It would have been obvious to make the recess of a sufficient depth as taught by Fuerst in the shoe of Pavone to prevent excessive wear on the insert and thereby extend the useful life of the shoe.

**(11) Response to Argument**

In response to applicants' arguments directed towards the 35 USC 112 rejections, these rejection are hereby withdrawn.

In response to applicants' arguments directed towards Schenkel, the insole of Schenkel is made from "a resilient material having shock-absorbing characteristics ...polyurethane" (column 4 lines 15-23) and states that the insole is allowed to "protrude or bulge in a generally downward direction through cutouts 28 and 30" (column 3 lines 11-12). The dictionary definition of "flow" is "to deform under stress without cracking or rupturing" as defined in Webster's Dictionary and the material which protrudes and bulges under force is considered to "flow". It is not understood what other definition of flow applicant is arguing or what specific limitations applicant is intending on encompassing with the term "flow". It is noted that in applicants' own disclosure on page 6 lines 18-25 that applicant acknowledges that "The extent that cushion 70 protrudes through apertures 42 and 44 depends on the wearer's weight and the force of the heel strike". This appears to suggest that under extreme circumstances, i.e. high weight and large force heel strike, that the cushion would protrude through the apertures to a great extent and may, even though undesired, contact the ground. There is no structure or specific guidelines that would ensure that the cushion would not contact the ground under extreme conditions.

In response to applicants' arguments directed towards claim 26, the material of Schenkel and/or Fuerst is polymeric and considered to be "gelatinous" inasmuch as applicant has defined and claimed such, i.e. the material is polymeric and protrudes and



bulges, i.e. has the consistency of gelatin or jelly (as is the definition of gelatinous in Webster's' New World Dictionary 3<sup>rd</sup> college edition).

In response to applicants' arguments directed towards Fuerst, Fuerst clearly states "said central portion is not ground engaging in normal play but engages the ground under appropriate player weight distribution conditions" (column 1 line 67- column 2 line 2). If the wearer does not at any time provide excessive force, i.e. sufficient weight distribution conditions, i.e. the only conditions in which the shoe is used is "normal play" or less force conditions such as merely walking, the central portion would be spaced above the floor or ground surface at all times as claimed. It is not that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). It is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. In re Swinehart, 169 USPQ 226 (CCPA1971). The structure of Fuerst is clearly capable of performing the function "said lower cushion surface of said first cushion....being spaced by ... at all times" especially when the wearer is low weight, participates in low force activities, etc..

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In response to applicants' arguments directed towards Pavone, the cushion is made of silicone material inflated with helium (see column 2 lines 50-65) and the outsole is made from a hard rubber (column 2 line 47) and since the outsole is made from a hard material and provides the aperture under the silicone material, the silicone will inherently bulge, flow, be forced down through the aperture in the hard rubber sole to some extent due to the materials used and the force applied. It is not an invention to perceive that the product which others had discovered had qualities they failed to detect. (National Distillers and Chemical Corp. v. Brenner, 156 USPQ 163, 854 OG 844).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Marie Patterson  
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Art Unit 3728

MDP

February 19, 2004

Conferees

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